



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,522	10/13/1999	MICHAEL NEHLS	8535-027-999	7547

7590 11/13/2002  
PENNIE & EDMONDS LLP  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 100362711

EXAMINER

MORAN, MARJORIE A

ART UNIT PAPER NUMBER

1631

DATE MAILED: 11/13/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/417,522	<b>Applicant(s)</b> NEHLS ET AL.	
	<b>Examiner</b> Marjorie A. Moran	<b>Art Unit</b> 1631	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 23 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 October 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 3 and 5-13.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Interview Summary

Continuation of 5. does NOT place the application in condition for allowance because: applicant's arguments are not persuasive and no amendments have been filed which overcome the rejections of record. In response to the argument that cells wherein genes involved in housekeeping or general survival are interrupted by a gene trapped sequence are expected to have a lower survival rate than cells wherein the interrupted gene is not one required for housekeeping or general survival, it is noted that the originally filed specification has not established, nor has applicant provided any evidence to support, that genes in cell with higher survival rates are necessarily those which (a) are not involved in housekeeping/general survival, or (b) are genes necessarily involved in cellular differentiation and development. It is noted that ANY gene needed for general survival of a cell is also a gene required for cellular development, and that genes involved in cellular differentiation may be different and distinct from genes involved in cellular development. Further, there is no evidence or disclosure that the claimed sequences are those from cells with higher survival rates, nor that the claimed sequences are known to be those involved in cellular differentiation and/or development. Applicant argues that his genes are "pre-selected" for sequences representing genes involved in differentiation of teratocarcinoma cells, but the originally filed specification fails to provide support that the claimed sequences are known to be involved in differentiation of any cells. In response to the argument that the claimed sequences may be used to identify regulators of cell differentiation or may be used as probes to isolate full-length cDNAs, applicant is again reminded that a "use" to do further research is not a utility under 35 USC 101. The claims are not directed to a micro-array, therefore arguments with regard to a micro-array are moot. In response to the argument that the claimed sequences are described by sequences and physical property, it is noted that sequences consisting of the claimed SEQ ID NO's are indeed described by the instant specification. However, as the claims recite open claim language and hybridization language, they encompass genetic sequences, and thereby encompass noncoding regions, introns, repetitive DNA, regulatory regions, etc. none of which is described by the instant specification. For the reasons previously set forth in the final office action, and set forth herein, the examiner maintains that the claims lack utility, enablement and written description..

MARJORIE MORAN  
PATENT EXAMINER

*Marjorie A. Moran*